

Appl. No. 09/654,253  
Response dated September 28, 2005  
Response to Office Action of June 28, 2005

### **Remarks/Arguments**

#### **Status**

Claims 1-20 are pending and stand rejected per a June 28, 2005 Office Action. The objections to the specification have been withdrawn. The June 28, 2005 Office Action was responsive to an Amendment and 37 CFR §1.131 Declaration filed on or about April 1, 2005 together with a Request for Continued Examination.

#### **Background**

On November 17, 2004 a Final Office Action concerning the above identified Application was mailed to Applicants. On January 18, 2005 an After Final Amendment & Response including a Rule 1.131 Declaration signed by the Applicants and a Declaration by Applicant's Representative in Accordance with MPEP 608.01(p) was filed with the US Patent & Trademark Office. On March 1, 2005 an Advisory Action was mailed to Applicant's Representative by the US Patent & Trademark Office. On April 1, 2005 an Amendment, a further Rule 1.131 Declaration signed by the Applicants, and a Request for Continued Examination was filed. On June 28, 2005 an Office Action was mailed to Applicant's Representative by the US Patent & Trademark Office.

#### **Summary of Present Response**

No claims have been amended, however a claim listing has been included for the Examiner's convenience. An additional Rule 1.131 Declaration (Declaration under 37 CFR

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§1.131) signed by the Applicants is attached where this Declaration refers to the Appendices I-III attached to the April 1, 2005 Declaration.

In view of the comments below and the enclosed 37 CFR §1.131 Declaration dated September 28, 2005, Applicant respectfully requests that the Examiner, reconsider the present application including claims 1-20, withdraw the rejection of these claims, and move this application to allowance.

a) Claims 1-6 and 8-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang et al. (U.S. Patent No. 6,560,755 B1).

Zhang et al qualifies as a reference, if at all, only under 35 U.S.C. 102(e), i.e. "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent ..." In view of the enclosed September 28, 2005 Rule 1.131 Declaration duly signed by the Applicants, the present invention was conceived before August 24, 2000 and due diligence was exercised from a date prior to August 24, 2000, the effective date of Zhang et al., to September 1, 2000, the filing date of the present Application and furthermore the present invention as claimed was not only conceived but was reduced to practice before August 24, 2000, the effective date of Zhang et al.

More particularly, the September 28, 2005 Rule 1.131 Declaration states "This Declaration and any attachments referenced herein is intended as a statement of facts sufficient to show, in accordance with MPEP 715.07 (A), reduction to practice of the claimed subject matter

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prior to the effective date of the "775 Patent" or, in accordance with MPEP 715.07 (C), conception of the invention prior to August 24, 2000, the effective date of the "775 Patent", coupled with due diligence from prior to the effective date of the "775 Patent" to September 1, 2000, the filing date of the Subject Application." Thus it is believed that the purpose and intent of the Declaration has been made clear.

Applicants have declared (see paragraph 4 of enclosed Declaration) that Appendix III was nearly identical from a substantive perspective to the Application as filed on September 1, 2000 and that Appendix III (draft Application of August 22, 2000) was provided to Applicants prior to August 24, 2000, i.e., the Subject Invention was reduced to practice (at least constructively) prior to the effective date (August 24, 2000) of the "775 Patent" (Zhang et al). Furthermore a comparison of the August 22, 2005 draft Application with the Subject Application also shows the two to be substantively nearly identical. Thus in accordance with MPEP 715.07 (A), the evidence in substance and weight clearly shows reduction to practice of the claimed subject matter prior to the effective date of the "775 Patent."

Furthermore, due diligence was practiced from the August 22, 2000 draft Patent Application (Appendix III) until the Subject Application was filed on September 1, 2000. As noted in the Declaration at paragraph 5.1, during this time period the draft Application was being reviewed and revised, formal figures were being prepared, and all other requisite patent application documents were being prepared. A meeting for a final review was scheduled when all parties could be in attendance, the documents were reviewed, and the Declaration, etc. was

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executed on August 31. The file wrapper will show the date of Execution of the Declaration and Power of Attorney by the Applicants to be August 31. Subsequent to final approval and sign-off on the Subject Application documents, the material was forwarded via Express Mail on the next day September 1, 2001 as will also be evidenced by the file wrapper for the Subject Application. Thus in accordance with MPEP 715.07 (C), the evidence in substance and weight clearly establishes conception of the invention prior to August 24, 2000, the effective date of the "775 Patent", coupled with due diligence from prior to the effective date of the "775 Patent" to September 1, 2000, the filing date of the Subject Application.

Thus and in view of the statement of facts and other evidence provided in the September 28, 2005 Rule 1.131 Declaration and Appendices I-III (filed with the April 1, 2005 Rule 1.131 Declaration), Applicant respectfully submits that Zhang et al is not a proper reference to support a rejection of claims 1-6 and 8-20 under 35 U.S.C. 103(a) since Zhang et al was filed after the invention by the Applicants. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 1-6 and 8-20 under 35 U.S.C. 103(a) based on Zhang et al. (U.S. Patent No. 6,560,755 B1)..

b) Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Zhang et al. (U.S. Patent No. 6,560,755 B1) in view of Hussey (U.S. Patent No. 5,826,269).

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See the discussion above at a). Given the effective date of Zhang et al and the September 28, 2005 Rule 1.131 Declaration as above noted, Zhang et al. is not a proper reference to support this §103(a) rejection of claim 7. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Zhang et al. (U.S. Patent No. 6,560,755 B1) in view of Hussey (U.S. Patent No. 5,826,269).

c) The Examiner has also requested detailed information regarding the question on page 2 of Appendix I (Patent Disclosure). The question reads "Has a product incorporating your idea been sold, offered for sale, placed in production, qualification, sampled, described in any publication (including Motorola promotional literature), marketed, shipped to anyone outside of Motorola (customer or distributor), or placed into inventory? Applicants when filing out the Patent Disclosure (Appendix I is a Patent Disclosure as filed out) responded YES to this question.

According to the enclosed September 28, 2005 Rule 1.131 Declaration, paragraph 3.1, the Applicants have declared that the redacted date was December 1, 1999 and that their "YES" response was provided "given our interpretation of the question and the belief that an experimental system then being internally evaluated was pursuant to qualifying for subsequent use a Mismatch Modeling Tool according to our idea and further that the Mismatch Modeling Tool was substantially according to the Mismatch Modeling Tool subsequently described and discussed in the draft Patent Application (Appendix III below) as well as the Subject

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Application." It is therefore respectfully submitted that sufficient information has been provided pursuant to the Examiner's request.

d) The Examiner has also requested detailed information regarding page 4 of Appendix II of Applicants' DECLARATION UNDER 37 C.F.R. § 1.131 dated April 1, 2005, the proposed solution includes "Automate the Motorola Mismatch Model in the form of a web-based tool" as well as at page 2, "Motorola has developed a new mismatch model". Appendix II is a copy of the Presentation to the Patent Committee that was provided by the Applicants when their invention was being considered for a patent application.

According to the enclosed September 28, 2005 Rule 1.131 Declaration, paragraph 3.2, the Applicants have declared "That the reference to "new mismatch model" on page 2 of the Presentation (Appendix II) referred to a mismatch model substantially as discussed and described in the Drennan dissertation cited in the Information Disclosure Statement which was filed concurrently with the Subject Application and that the reference to "Automate the Motorola Mismatch Model on page 4 referred to a Mismatch Modeling Tool substantially according to the Modeling Tool discussed and described in the draft US Patent Application (Appendix III) as well as the Subject Application." It is therefore respectfully submitted that sufficient information has been provided pursuant to the Examiner's request.

e) Accordingly, Applicant respectfully submits that the application, as amended, clearly and patentably distinguish over all appropriately cited references of record and as such are to be deemed allowable. Such allowance is hereby earnestly and respectfully solicited at an early date.

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If the Examiner has any suggestions or comments or questions, calls are welcomed at the phone number below.

Although it is not anticipated that any fees are due or payable since this response is being timely filed within the allowed time period and no other fees appear to be due or payable, the Commissioner is hereby authorized to charge any fees that may be required to Deposit Account No. 50-3435.

Respectfully submitted,

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Attachments:

Declaration by Applicants under 37 CFR §1.131

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